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Cord a laser capture microdissection transfer film coupled to said substrate surface of said transfer film carrier.

REMARKS

This is a continuation prosecution application under 37 C.F.R. § 1.53(d) of U.S. application Serial No. 08/984,979 filed on December 4, 1997. Applicants have filed this continued prosecution application in response to the final Office Action dated October 4, 2000 (Paper No. 12) for which the three-month date for response is January 4, 2001. Claims 1-44 were pending in this application. Claims 1-44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over International Publication No. WO 98/35215 to Baer et al. (hereinafter "Baer"). New claims 49-77 have been added to reintroduce the original claims because applicants believe that they were improperly rejected under 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a). Accordingly, claims 1-44 and 49-77 are currently under consideration. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented.

Rejections Under § 103(a)

In the final Office Action dated October 4, 2000, claims 1-44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Baer. The Office Action stated that Baer discloses a LCM apparatus comprising a transfer film carrier having a substrate surface and a LCM transfer film coupled to the carrier. The Office Action further stated that Baer discloses the claimed invention except for the integrally formed structure. The Office Action further stated that using the integrally formed structure for controlling the space between the transfer film and the sample is well known in the art so it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Baer's apparatus with the integrally formed structure

to control the spacing to reduce the system cost. To support the rejection, the Examiner cited U.S. Patent No. 3,684,099 issued on August 15, 1972 to Kiebach.

Rejections Under § 102(e)

In the Office Action dated March 14, 2000, claims 16 and 31 were rejected under 35 U.S.C. § 102(e) as being anticipated by Baer. In particular, the Office Action stated that with respect to claim 16, Baer discloses a laser capture microdissection apparatus comprising a transfer film carrier having a substrate surface, a LCM transfer film coupled to the carrier. With respect to claim 31, the Office Action stated that Baer discloses a LCM assembly comprising a plate having a top surface, a LCM cap coupled to the plate comprising a carrier coupled to the transfer film.

Baer is Not Prior Art

The pending rejection under § 103(a) made in the final Office Action dated October 4, 2000 as well as the previous rejection under § 102(e) made in the Office Action dated March 14, 2000 are both improper because Baer is not prior art. Baer is a foreign publication that has a publication date of August 13, 1998. This publication date is after the filing date of December 4, 1997 of the present application. Baer is not prior art because the Baer publication does not antedate the filing date of the present application.

Furthermore, Baer is not prior art because it fails to satisfy the requirements set forth in 35 U.S.C. § 102(e). Under § 102(e):

A person shall be entitled to a patent unless-
(e) the invention was described in a *patent granted* on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or *on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title* before the invention thereof by the applicant for patent

35 U.S.C. § 102(e) (emphasis added). Baer is an international application for which the requirements of paragraphs (1), (2), and (4) of section § 371(c) have not been satisfied. Moreover, Baer is not a patent granted on an international application. For § 102(e) to apply the reference must be a U.S. Patent with a filing date earlier than the effective filing date of the application. MPEP §706.02(a); MPEP §2136 (“The reference must be a U.S. patent to be eligible for use in a 35 U.S.C. 102(e) rejection.”); MPEP § 2127(III) (“Furthermore, the contents of a foreign patent application should not be relied upon as prior art until the date of publication (i.e., the insertion into the laid open application) can be confirmed by an examiner’s review of the copy of the document.”). Because the requirements of § 102(e) are not satisfied, the rejection under § 102(e) is improper. Also, the obviousness rejection under § 103(a) is improper because Baer is not prior art under § 102(e). Hence, applicants have added claims 49-77 to reintroduce claims that were amended due to the improper rejection. These added claims are substantially identical to the claims that were previously amended to overcome the erroneous rejection under § 102(e). Therefore, applicants respectfully request reconsideration and allowance of all claims.

The Parent of Baer Does Not Preclude Patentability

Baer claims priority to U.S. Patent Application Serial No. 08/797,026 which issued on January 12, 1999 to Baer et al. as U.S. Patent No. 5,859,699 (hereinafter “the ‘699 patent”). A copy of the ‘699 patent is attached. The ‘699 patent does not preclude patentability of the claims because of § 103(c). Under § 103(c),

Subject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

35 U.S.C. § 103(c). Effective November 29, 1999, subject matter which was prior art under former § 103 via § 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention “were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” 35 U.S.C. § 103(c). This change to 35 U.S.C. § 103(c) applies to a utility application filed on or after November 29, 1999 including continued prosecution applications filed under 37 C.F.R. 1.53(d). MPEP § 706.02(l)(1). The mere filing of a continuing application on or after November 29, 1999 will serve to exclude commonly owned § 102(e) prior art that was applied or could have been applied, in a rejection under § 103 in the parent application. MPEP § 706.02(l)(1).

Accordingly, applicants have filed a continuation application under 37 C.F.R. 1.53(d) and believe that § 103(c) applies to disqualify the ‘699 patent as prior art that could be applied in a rejection under § 103.

Common Ownership of Baer and the ‘699 Patent is Established

In order to be disqualified as prior art under 35 U.S.C. § 103(c), the subject matter which would otherwise be prior art to the claimed invention and the claimed invention must be commonly owned at the time the claimed invention was made. 35 U.S.C. § 103(c); MPEP § 706.02(l)(2). In order to establish such common ownership, applicants rely on 37 C.F.R. § 1.104(a)(5)(i). Under 37 C.F.R. § 1.104(a)(5)(i):

- (5) Copending applications will be considered by the examiner to be owned by, or subject to an obligation of assignment to, the same person if:
 - (i) The application files refer to assignments recorded in the Patent and Trademark Office in accordance with Part 3 of this chapter which convey the entire rights in the applications to the same person or organization

See also, MPEP §706.02(1)(2)(II). Accordingly, applicants have attached copies of assignments and recordations of assignments for the instant application and for the '699 patent as evidence of common ownership of the copending applications at the time the instant invention was made.

The entire rights of both applications were assigned to the same organization, Arcturus Engineering, Inc. of Mountain View, CA. The assignment of application serial number 08/984,979 was recorded at reel 9117, frame 0541. The '699 patent, having an application serial number 08/797,026 was recorded at reel 8469, frame 0606. Applicants believe that the requirements for establishing common ownership as required under § 103(c) have been satisfied under 37 C.F.R. §1.104(a)(5)(i). Therefore, the '699 patent is disqualified as prior art.

CONCLUSION

Applicants submit that this application is in a condition for allowance by way of the amendments and remarks presented herein to overcome rejections that were raised in the final Office Action. Accordingly, reconsideration and allowance of all claims are respectfully requested. If it is determined that a telephone conversation would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. **485772000400**. However, the Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

By: 

Rimas T. Lukas
Registration No. 46,451

Morrison & Foerster LLP
755 Page Mill Road
Palo Alto, California 94304-1018
Telephone: (650) 813-5905
Facsimile: (650) 494-0792